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Attorney's Docket No.: 08575-074001

REMARKS

Claims 1-43 are pending in the above-identified patent application. Claims 1, 23, and 41 are independent.

Claim Rejections – 35 U.S.C. §101

The examiner rejected claims 1-22 and 42 under 35 U.S.C. §101 on the ground that the claimed invention is allegedly directed to non-statutory subject matter.

Specifically, the examiner contended that, “[f]or a method to pass muster, the recited method must somehow apply, involve, use, or advance the technological arts. In the instance case, claim 1, only recites an abstract idea. The recited steps of merely displaying a list of vaguely defined potential other entities, receiving information from one entity to another entity and abstract display of potential other entities with whom the user may [or may not] have account does not apply, involve, or advance the technical arts” (page 2 of the Office Action). Applicant respectfully disagrees.

In the recent decision of *Ex Parte Lundgren* (Appeal No. 2003-2088), the majority of the Board of Patent Appeals and Interferences stated:

Our determination is that there is currently no judicially recognized separate “technological arts” test to determine patent eligible subject matter under §101. We decline to create one. Therefore, it is apparent that the Examiner’s rejection cannot be sustained.

Thus, contrary to the examiner’s position, under current patent law jurisprudence there is no requirement that a recited method in a claim apply, involve, or advance technical arts.

Notwithstanding that there is no requirement that a claim be directed to a technological art, applicant submits that in any event the method recited in claim 1 is in fact directed to a technological art. Claim 1 recites, for example, “automatically determining, by a first entity and using data associated with a user, a list of one or more other entities that provide network-accessible accounts.” This feature is performed automatically, for example, by a CPU-based device, and thus this feature applies or involves technical arts, such as computer and automation technology arts.

Applicant thus traverses the examiner’s rejections under 35 U.S.C. §101.

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Claim Rejections – 35 U.S.C. §112

The examiner rejected claims 1-43 under 35 U.S.C. §112, 1st paragraph, as failing to comply with the written description requirement. Specifically, the examiner contended that “[t]he disclosure lacks clear written description in the description of how to determine a list of one or more other entities that provide network-accessible account being performed automatically, by a first entity or other entities. The disclosure also lacks description how to determine an undefined ‘potential other entities’.” (page 3 of the Office Action). Applicant respectfully disagrees.

A description of how applicant's method determines a list of one or more entities is provided in considerable detail in, among other places, FIG. 2, page 10, lines 7-14, and page 11, line 20 to page 14, line 14, of the originally filed application. For the examiner's convenience, reproduced below is an excerpt from the detailed description, appearing on page 12, lines 8-20, that discusses how lists of other entities are determined.

As described above, process 200 generates (216) a list of other institutions managing network-accessible accounts that might be owned by user 102 from personalization data about the customer and rule set stored in data table 126. This generation is done by categorizing all of the institutions with network-accessible accounts that are known to process 200 in data table 125 and applying rules to determine which of these institutions should be displayed to user 102. This personalization data can include automatically-collected data as well as data from the manual personalization test entered by user 102.

Process 200 generates (216) this list of institutions to present to user 102 by applying the rule set stored in data table 126 to the personalization data. These rules are stored in database 118 in section 122. The rules take the form of IF [condition] THEN [action]. The condition portion of these rules looks at the existence of some data in the personalization data for user 102. In some implementations, these rules are applied to the personalization data in data tables 130 and 132 in two or more iterations.

Further detail regarding the list determination procedure is provided throughout the specification of the originally filed application.

Additionally, regarding the alleged undefined “other entities”, the specification makes it abundantly clear that other entities refer to institutes, organization, and the like. In one example the entities referred to are financial institutes that provide financial accounts (page 3, lines 29-31 of the originally filed application).

Applicant thus traverses the examiner's rejections under 35 U.S.C. §112, 1st paragraph.

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Claim Rejections – 35 U.S.C. §112, 2nd paragraph

The examiner rejected claims 1, 23, and 41 under 35 U.S.C. §112, 2nd paragraph on the ground that “[c]laims 1, 23, 41 are vague and indefinite because it is unclear how to automatically determining a list of one or more other entities that provide network-accessible accounts” (paragraph 6 on page 3 of the Office Action). Applicant respectfully disagrees.

As provided in MPEP 2173:

The primary purpose of this requirement of definiteness of claim language is to ensure that the scope of the claims is clear so the public is informed of the boundaries of what constitutes infringement of the patent.

Applicant considers the feature “automatically determining, by a first entity and using data associated with a user, a list of one or more other entities that provide network-accessible accounts” to be clear so as to inform the public of circumstances in which infringement of applicant’s invention would occur. Specifically, the above feature clearly provides that applicant’s invention would be practiced when, in combination with the other recited features of claims 1, 23, and 41, a list of one or more entities that provide network-accessible accounts is determined using data associated with a user. Applicant notes that there are many embodiments for practicing applicant’s feature of “automatically determining”, and that some of those embodiments are described in the claims that depend from the independent claims (see, for example, claims 2-11). Applicant’s invention, however, includes all embodiments in which a list is automatically determined, and applicant does not believe that it is necessary or required to describe in independent claims 1, 23, and 41 how to automatically determine a list of one or more other entities.

The examiner further rejected claims 1, 23 and 41 under 35 U.S.C. §112, 2nd paragraph, as being incomplete for omitting essential steps, alleging that such omission amounts to a gap between the steps, as per MPEP §2172.01. Applicant respectfully disagrees.

How to automatically determine a list of one or more other entities that provide network-accessible account is not a missing essential element, but merely a more detailed (and thus narrower) description of applicant’s claimed feature. As explained above, applicant’s invention may be practiced using a myriad of embodiments pertaining to the automatic determination of a

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list. For example, as described in claims 2-4, in one embodiment pertaining to the automatic determination of a list, applicant's method determines personalization data associated with the user such as identifying characteristics shared by a pre-defined group of users. One such characteristic, as provided by claim 4, can be a geographical location. Thus, in one embodiment of applicant's invention, a list of other entities is determined, for example, by considering the geographic location associated with the user (e.g., where the user lives) and thereby determining other entities that may be located proximate to that geographical locale.

Applicant further notes that applicant's independent claims recite that a list of other entities is automatically determined, that a user selects at least one second entity from the automatically determined list, and provides access information with respect to the selected at least one selected entity. Thus, contrary to the examiner's rejection, no gap exists between the various recited features, and no essential feature is omitted.

The examiner also rejected claims 1, 23, and 41 under 35 U.S.C. §112, 2nd paragraph, on the ground that there is insufficient antecedent basis for the term "other entities" in the claims.

Applicant respectfully disagrees. Claims 1, 23, and 41 all recite "a list of one or more other entities", and subsequently recite "receiving from the user at least one second entity from the list of one or more other entities". The recited element is thus the list (which happens to be a list of one or more other entities). Accordingly, proper antecedent basis exist for the terms recited in claims 1, 23, and 41.

Applicant thus traverses the examiner's rejections under 35 U.S.C. §112, 2nd paragraph.

Claim Rejections – 35 U.S.C. §102

The examiner maintained his rejections of claims 1-43 under 35 U.S.C. §102(e) as being unpatentable by U.S. Publication No. 2002/0194502 to Sheth et.

Specifically, the examiner stated that "Sheth et al. disclose a system and method comprising: automatically determining, by a first entity (grantor) and using data associated with a user, a list of one or more other entities that provide network-accessible accounts (Host Server 1010)" (page 4 of the Office Action). Applicant respectfully disagrees.

Applicant's independent claim 1 describes a method that includes "automatically determining, by a first entity and using data associated with a user, a list of one or more other

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entities that provide network-accessible accounts." Thus, as explained in applicant's response to the March 10, 2005, Office Action, applicant's method enables a first entity, such as a financial institution with which a user has a web-accessible account, to determine a list of potential other entities (e.g., other financial institute) with whom the user may have accounts it may also access through a network. That list of potential other entities is determined using user-specific data associated with that user that is available to the first entity. For example, the user-specific data may include the name and address of the user (page 11, lines 22-23 of the originally filed application). By determining such a list and presenting it to the user, the user may select from the list other entities with whom it has network-accessible accounts, and provide the first entity with access information for such accounts so that the user may access and manage its various accounts from a single platform.

In contrast, Sheth discloses an information aggregation system through which a user can aggregate information from several sources and present the information uniformly on a single interface (page 1, paragraph 3). Sheth further describes that a user can populate the user's interface by selecting institutes/web-sites from an alphabetic list of such institutes/web-sites stored on a database 416, or by using a search function to find institutes/web-sites to add to the user's monitor (FIG. 8A, and paragraph 75 on page 6). Thus, populating the user-interface is performed on the basis of a single global alphabetic list that is used for all the users using Sheth's system, and/or on a basis of specific web-sites entered by the user. So unlike applicant's claim 1, Sheth does not identify potential institutes and/or web-sites on the basis of user-specific data associated with that user, such as the user's name and address. Accordingly, Sheth does not disclose or suggest "automatically determining, by a first entity and using data associated with a user, a list of one or more other entities that provide network-accessible accounts," as required by applicant's claim 1.

Since Sheth does not disclose at least the feature of "automatically determining, by a first entity and using data associated with a user, a list of one or more other entities that provide network-accessible accounts," applicant's independent claim 1 is therefore patentable over the cited art.

Claims 2-22 and 42 depend from independent claim 1 and are therefore patentable for at least the same reasons as independent claim 1.

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Claims 23 and 41 recite "automatically determine, using the data associated with the user, a list of one or more entities that provide network-accessible accounts," or similar language. For reasons similar to those provided with respect to independent claim 1, at least this feature is not disclosed by the cited art. Accordingly, independent claims 23 and 41 are patentable over the cited art. Claims 24-40 and 43 depend from independent claim 23, and are patentable over the cited art for at least the same reasons as independent claim 23.

It is believed that all the rejections and/or objections raised by the examiner have been addressed.


All of the dependent claims are patentable for at least the reasons for which the claims on which they depend are patentable.

Canceled claims, if any, have been canceled without prejudice or disclaimer. Any circumstance in which the applicant has (a) addressed certain comments of the examiner does not mean that the applicant concedes other comments of the examiner, (b) made arguments for the patentability of some claims does not mean that there are not other good reasons for patentability of those claims and other claims, or (c) amended or canceled a claim does not mean that the applicant concedes any of the examiner's positions with respect to that claim or other claims.

No fee is believed due. Please apply any charges or credits to deposit account 06-1050, referencing attorney docket 08575-074001.

Respectfully submitted,

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